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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,489	11/14/2003	Hau H. Duong	067456-5012-US02	1026
67374 7590 11/27/2009 MORGAN, LEWIS & BOCKIUS, LLP (SF) ONE MARKET SPEAR STREET TOWER SAN FRANCISCO, CA 94105				
EXAMINER				
LU, FRANK WEI MIN				
ART UNIT		PAPER NUMBER		
1634				
MAIL DATE		DELIVERY MODE		
11/27/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/714,489

Applicant(s)

DUONG ET AL.

Examiner

FRANK W. LU

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-26 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 13, 17, 18 and 20-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's response to the office action filed on July 14, 2009 has been entered. The claims pending in this application are claims 12-26 wherein claims 14-16 and 19 have been withdrawn due to species election mailed on May 27, 2007. Rejection and/or objection not reiterated from the previous office action are hereby withdrawn in view of applicant's amendment filed on July 14, 2009. Claims 12, 13, 17, 18, and 20-26 will be examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. New Matter

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation "detecting a plurality of different ETMS each having different potentials as a measure of the presence of a plurality of different target analytes" is added to the newly added dependent claim 26. Although the specification describes that "[T]he use of metal ions to connect the nucleic acids can serve as an internal control or calibration of the system, to evaluate the number of available nucleic acids on the surface. However, as will be appreciated by those in the art, if metal ions are used to connect the nucleic acids to the conductive oligomers, it is

generally desirable to have this metal ion complex have a different redox potential than that of the ETMs used in the rest of the system, as described below” and “[P]referred ETMs include, but are not limited to, transition metal complexes, organic ETMs, and electrodes” (see page 20, paragraphs [0183] and [0187] of US 2004/0146909 A1, which is US publication of this instant case), the specification fails to define or provide any disclosure to support such claim limitation recited in claim 26 since the claim does not require that one of different ETMS is a transition metal complex. Furthermore, in applicant’s remarks filed on July 14, 2009, applicant does not indicate which part in the specification supports such claim limitation recited in claim 26.

MPEP 2163.06 notes “IF NEW MATTER IS ADDED TO THE CLAIMS, THE EXAMINER SHOULD REJECT THE CLAIMS UNDER 35 U.S.C. 112, FIRST PARAGRAPH - WRITTEN DESCRIPTION REQUIREMENT. *IN RE RASMUSSEN*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).” MPEP 2163.02 teaches that “Whenever the issue arises, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed...If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application.” MPEP 2163.06 further notes “WHEN AN AMENDMENT IS FILED IN REPLY TO AN OBJECTION OR REJECTION BASED ON 35 U.S.C. 112, FIRST PARAGRAPH, A STUDY OF THE ENTIRE APPLICATION IS OFTEN NECESSARY TO DETERMINE WHETHER OR NOT “NEW MATTER” IS INVOLVED. *APPLICANT SHOULD THEREFORE SPECIFICALLY POINT OUT THE SUPPORT FOR ANY AMENDMENTS MADE TO THE DISCLOSURE*” (emphasis added).

4. Claims 12, 13, 17, 18, and 20-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 25 is rejected as vague and indefinite. Since any part of a molecule which can transfer an electron can be considered as electron transfer moiety (ETM), the assay complex comprises a target analyte, a capture analyte and an electron transfer moiety that is response to an input waveform, and the claim does not indicate that said ETM only associates with said

target analyte and does not associate with said capture analyte, it is unclear why an output waveform generated from an input waveform can indicate the presence of said target analyte and cannot indicate the presence of said capture binding ligand. Please clarify.

6. Claim 25 is rejected as vague and indefinite because it is unclear that the analyzing the output waveform using peak recognition of what. Please clarify.

7. Claim 26 is rejected as vague and indefinite. Since the claim does not indicate that a plurality of different ETMs only associates with a plurality of different target analytes and does not associate with said capture analyte, it is unclear why detecting said plurality of different ETMS can be used as a measure of the presence of said plurality of different target analytes and cannot used as a measure of the presence of said capture binding ligand in claim 25. Please clarify.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 12, 13, 17, 18, and 20-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,740,518 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims in this instant application are either anticipated by, or would have been obvious over, the reference claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). Although claims 12, 13, 17, 18, and 20-26 in this instant application are not identical to claims 1-27 of U.S. Patent No. 6,740,518 B1, the contents of U.S. Patent No. 6,740,518 B1 teach that electronic detection is by chronocoulometry (see column 85, last paragraph bridging to column 86, first paragraph), the output current is fed into the lock-in amplifier (see column 103), ETM can be transition metal complexes (see column 14, 29-48), and the AC frequency ranges from about 0.01 Hz to about 100 MHz, with from about 10 Hz to about 10 MHz being preferred, and from about 100 Hz to about 20 MHz being especially preferred (see column 79, lines 25-41), and “at least one electrode” in claim 1 of U.S. Patent No. 6,740,518 B1 means one or more electrodes, claims 1-27 of U.S. Patent No. 6,740,518 B1 are directed to the same subject matter and fall entirely within the scope of claims 12, 13, 17, 18, and 20-26 in this instant application. In other words, claims 12, 13, 17, 18, and 20-26 in this instant application are anticipated by claims 1-27 of U.S. Patent No. 6,740,518 B1.

Response to Arguments

In page 6, last paragraph of applicant's remarks, applicant argues that "[T]he claims have also been rejected on alleged nonstatutory double-patenting grounds. While Applicants disagree with this characterization (the issued patent is directed to higher harmonics analysis techniques and the instant application claims are addressed to peak evaluation), Applicants nonetheless are happy to supply a terminal disclaimer upon notice of otherwise allowable subject matter (should the Examiner still hold that position)".

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection because claim 4 of U.S. Patent No. 6,740,518 B1 teaches peak evaluation and applicant has not filed a terminal disclaimer.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. No claim is allowed.
12. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Nguyen, can be reached on (571)272-0731.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frank W Lu /
Primary Examiner, Art Unit 1634
November 18, 2009